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Technology Center-2600

Director of Technology Center 2600
Commissioner for Patents
Washington, D.C. 20231

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Re: **Application Serial No.:** 08/889,033
Appellants: Bartholomew J. Frazzitta, et al.
Title: Transaction System
Docket No.: D-1083

Sir:

Please find enclosed Appellants' Petition that an Examiner's Answer contains an impermissible new ground of rejection for filing in the above-referenced application. Pursuant to 37 C.F.R. § 1.181, no fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with this Petition and any other fee due to Deposit Account 04-1077.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post-Office to addressee in an envelope addressed to Director of Technology Center 2600, Commissioner for Patents, Washington, D.C. 20231 this 21st day of May 2001.

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D-1083

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
Bartholomew J. Frazzitta, et al.)	
)	Art Unit 2613
Serial No.: 08/889,033)	
)	Patent Examiner
Filed: July 7, 1997)	Tung Vo
)	
Title: Transaction System)	

Commissioner for Patents
Washington, D.C. 20231

Sir:

The following dates and papers are associated with this application:

1. 07/17/00 Final Rejection
2. 08/04/00 Request for Withdrawal of Premature Final Rejection
3. 10/05/00 Notice of Appeal
4. 01/03/01 Appeal Brief
5. 05/07/01 Final Rejection

The Office Action ("Action") dated 05/07/01 is viewed by Appellants as an Examiner's Answer. Since prosecution has not been reopened, then the response by the Office to the Appeal Brief must be treated as an Examiner's Answer. The Action does not refer to any other paper except the Appeal Brief. Appellants reserve all rights to file a Reply Brief. If a request for reconsideration is first required, then this petition should be considered as such.

**PETITION THAT AN EXAMINER'S ANSWER CONTAINS AN
IMPERMISSIBLE NEW GROUND OF REJECTION**

Appellants respectfully petition that the Examiner's Answer (Action dated 05/07/01) in the above referenced application contains an impermissible new ground of rejection. 37 C.F.R. § 1.193(a)(2) clearly prohibits the entry of a new ground of rejection in an Examiner's Answer. Therefore, Appellants respectfully request that the Examiner's Answer be withdrawn.

The status of the claims from which the appeal was taken included only two rejections:

1. Claims 1-16 and 18-47 were rejected pursuant to 35 U.S.C. § 103(a) as obvious over Casale et al. in view of Bustos and McClure et al.
2. Claim 17 was rejected pursuant to 35 U.S.C. § 103(a) as obvious over Casale et al. in view of Bustos and McClure et al. and further in view of Kaehler.

The Examiner's Answer (Action dated 05/07/01) includes three rejections:

1. Claims 1-4, 12-13, 18-19, 24-27, 37-42, and 47 were rejected pursuant to 35 U.S.C. § 103(a) as obvious over Casale et al. in view of Bustos.
2. Claims 5-11, 14-16, 20-23, 28-36, and 43-46 were rejected pursuant to 35 U.S.C. § 103(a) as obvious over Casale et al. in view of Bustos and McClure et al.
3. Claim 17 was rejected pursuant to 35 U.S.C. § 103(a) as obvious over Casale et al. in view of Bustos and McClure et al. and further in view of Kaehler.

As can be seen, the rejections based solely on "Casale et al. in view of Bustos" were not present in the Final Action (dated 07/17/00) from which the appeal was taken. Thus, the additional rejections and the corresponding application of references in the Action constitutes an impermissible new ground of rejection.

Furthermore, Appellants also respectfully submit that their Appeal Brief arguments against the prior art rejections were based on the Office's interpretation of the references as presented and applied in the Final Action (dated 07/17/00) and from which the appeal was taken. However, the Action raises new issues, new interpretations, and new applications of references. The Action's statement that "the examiner must clarify the grounds of rejection" is an admission of such. Therefore, it is respectfully submitted that the Action further contains an impermissible new ground of rejection.

Appellants respectfully submit that the Action includes at least one impermissible new ground of rejection within the meaning of 37 C.F.R. § 1.193(a)(2), which prohibits the entry of a new ground of rejection in an Examiner's Answer. Therefore the inclusion of the new ground of rejection in the Examiner's Answer is legally improper due to noncompliance with the clear wording of both the statute and the regulations, and the Office procedures promulgated thereunder. Appellants respectfully request that the Examiner's Answer (Action dated 05/07/01) be withdrawn.

Prosecution has not been reopened

Furthermore, in order to enter a new ground of rejection after Appellants' Brief has been filed, the examiner, with supervisory approval, must reopen prosecution. Note MPEP § 1208.01 and 1208.02. However, there is no indication that prosecution has been reopened. Nor is there any indication of supervisory approval for reopening prosecution.

Prosecution cannot be made final

Furthermore, even if the Office were to properly reopen prosecution (which it has not), the prosecution cannot be made final. Thus, the final rejection is premature. Appellants

respectfully submit that the finality of the Action should be withdrawn. As previously discussed, a new ground of rejection was applied in the Action. Thus, the rejection cannot be made Final.

MPEP § 1208.02 states:

An Office Action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no certification was filed.

Appellants respectfully submit that neither condition (A) or (B) apply. Thus, the Action cannot be made final.

Additionally, MPEP § 706.07(a) states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Furthermore, even if the Office were to properly reopen prosecution (which it has not), then Appellants are entitled to certain options, including the filing of a reply or requesting reinstatement of the appeal (37 C.F.R. § 1.193(b)(2); MPEP § 1208.02). However, Appellants have not been provided said options in the Action. Furthermore, because of the finality of the rejection in the Action, Appellants have not been given an opportunity in accordance with 37 C.F.R. § 1.111 to properly rebut the Office's new ground of rejection. Nor have Appellants been given the opportunity to request reinstatement of the appeal. Thus, closing of the prosecution is improper. Thus, the final rejection is premature and improper.

Appellants respectfully submit that the Final rejection (i.e., the Examiner's Answer) should be withdrawn as it is legally improper.

The Action is improper

As previously discussed, Appellants' filed a Notice of Appeal and then an Appeal Brief. The Office has responded to Appellants' Appeal Brief with a Final Rejection Action. Appellants respectfully submit that the Action is not in compliance with the statutes, rules, or Office procedures. Thus, Appellants respectfully request that the Action be withdrawn. Appellants' previously filed Appeal and Appeal Brief remain in effect.

If necessary, then reconsideration is requested

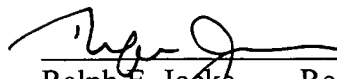
If a request for reconsideration is first required, then Appellants respectfully request reconsideration for withdrawal of the Examiner's Answer. Additionally, if a request for reconsideration is first required, then Appellants, if necessary, respectfully request reconsideration of the finality of the rejection in the Action dated 05/07/01. If a request for reconsideration is first required, then this petition should be considered as such.

Conclusion

Appellants respectfully submit that the Examiner's Action contains at least one impermissible new ground of rejection within the meaning of 37 C.F.R. § 1.193(a)(2) which clearly prohibits the entry of a new ground of rejection in an Examiner's Answer. Appellants respectfully request that the Examiner's Answer (the Action dated 05/07/01) be withdrawn. Appellants further respectfully request, if necessary, that the finality of the Action be withdrawn.

Appellants respectfully request that their petition be granted.

Respectfully submitted,



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